



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/636,660	08/11/2000	Tom Evslin	176/1	9188

7590 11/03/2004
Jeffrey I. Kaplan, Esq.
KAPLAN & GILMAN, L.L.P.
900 Route 9 North, 5th Floor
Woodbridge, NJ 07095

EXAMINER

NGUYEN, BRIAN D

ART UNIT	PAPER NUMBER
----------	--------------

2661

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/636,660

Applicant(s)

EVSLIN ET AL.

Examiner

Brian D Nguyen

Art Unit

2661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on the amendment filed 8/4/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. Specification is objected to because of the following informalities

Page 4, line 2, it is suggested to change "server **105**" to ---server **106**---.

Page 7, line 3, it is suggested to change "us" to ---is---.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al (6,587,867) in view of Galasso et al (6,374,302).

Regarding claims 1-3, Miller discloses an apparatus comprising a stored table of information (subscriber profile databases) indicative of plurality of parties to be contacted and within a local community of interest corresponding to a specified set of one or more computers and to which the apparatus can directly route the contact, the stored table including a network address for each party within the local community of interest, and an indicator of which of at least two networks (cellular network, PSTN, Internet) over which the contacted party desired to be contacted; at least two network interface units, each for interfacing to a separate one of the at least two networks for receiving requests to contact parties; and a processor for completing the contact at the address and over the network stored in the table, and if not, sending the contact to a

Art Unit: 2661

different server over the Internet (see abstract; col. 1, lines 13-20; col. 5, lines 32-35). Miller does not specifically disclose contact a domain name server over the Internet if the party to be contacted is not in the local community of interest. However, Galasso discloses contacting the server if the party to be contacted is not in the local community of interest (see col. 2, lines 16-34; col. 2, lines 44-53; col. 4, line 41-col. 5, line 7). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to contact the server as taught by Galasso in the system of Miller so that call can be forwarded to its destination.

Regarding claims 4-5, Galasso further discloses receiving information from the DNS, to parse the information to ascertain a network address of a second server having a local community of interest of which the party to be contacted is a part, and for establishing communications over the Internet between the apparatus and the second server; monitoring signals received from the second server during call setup, and for determining when to begin transmission of audio communications (see 620, 630 of figure 4; col. 1, line 36-col. 2, line 5; col. 5, lines 58-64; col. 7, line 44-col. 8, line 7). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to contact the server and use the received information to establish a connection with the called party as taught by Galasso in the system of Miller in order to establish a communication between a source and a destination.

Regarding claim 6, claim 6 is a method claim that has substantially all the limitation of the respective apparatus claims 1-5. Therefore, it is subject to the same rejection.

Regarding claim 7, Galasso discloses the identification of the called party includes an email address associated with the called party (see table 1 in col. 5). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the

Art Unit: 2661

email address as the identification as taught by Galasso in the system of Miller so that different addresses can be used to identify a called party.

Regarding claims 8-10, Miller discloses using the graphical user interface to update the table (subscriber profile) (see col. 4, lines 26-32).

Regarding claims 11-15, claims 11-15 are method claims that have substantially all the limitations of the respective apparatus claims 1-5. Therefore, they are subject to the same rejection.

Regarding claims 16-18, Miller discloses the called party can change the table (subscriber profile) and prioritizing sets of information (see abstract; figures 10-12; col. 12, line 1-col. 13, line 20).

Response to Arguments

4. Applicant's arguments filed 8/4/04 have been fully considered but they are not persuasive.

The applicant argued that *Miller does not disclose a table that stores both network addresses and desired networks to be used to reach a contacted party. Miller does not disclose two separate networks from which to receive, and to which to send, contacts, and Miller does not disclose determining if the contacted party is within the local community of interest.* The examiner disagrees because Miller discloses all of these limitations. In the abstract, Miller discloses that "The subscriber profile (table) specifies which communication services the subscriber wishes to provide to different people who call the subscriber's telephone number" and in col. 1, lines 16-20, Miller defines the telecommunication services include: automatic routing

Art Unit: 2661

services, voice mail services, facsimile services, paging services, cellular phone services and personal 800 numbers. When a caller calls the subscriber using a single telephone number, the call will be routed to the subscriber through one of the services provided to the subscriber based on the priority of each communication service set by the subscriber. Therefore, Miller does teach *a table that stores both network addresses and desired networks to be used to reach a contacted party*. The telecommunication services provided by Miller use both a circuit switch network and a data network. In col. 1, lines 59-61, Miller discloses the communication system is coupled to the Internet and in col. 4, lines 47-51, Miller teaches the call may reach the service provider in any of a number of different ways including circuit switch and packet switch. Therefore, Miller teaches *two separate networks from which to receive, and to which to send, contacts*. Miller inherently discloses *determining if the contacted party is within the local community of interest* because when Miller's system search the subscriber profile to route the call to the subscriber, the search will determine if the subscriber is local to the server that performing the search. The applicant also argued that *Galasso merely a technique for completing contacts over the Internet by means of a gatekeeper*. However, there would be no motivation to combine Galasso with Miller, because Miller does not complete calls over the Internet at all, and hence would have no use for the gatekeeper of Galasso. The examiner disagrees because Miller does teach complete calls over the Internet as described above and the use of a domain name server such as the one disclosed by Galasso is obvious because the local server's database do not contain every addresses existing in the world. Therefore, it is necessary for the local server to contact the domain name server to search for unknown addresses. The examiner also would like to remind the applicant that the system disclosed by Miller is for personal use such that a caller need to

Art Unit: 2661

remember only one telephone number to contact the subscriber at different locations through cellular phone, 800 number, voicemail, paging etc. and not for business use such as routing the call to the billing department or customer complaint department as argued on page 6 of the remark.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian D Nguyen whose telephone number is (571) 272-3084. The examiner can normally be reached on 7:30-6:00 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kenneth Vanderpuye can be reached on (571) 272-3078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



10/28/04

**BRIAN NGUYEN
PRIMARY EXAMINER**